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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,481	03/09/2001	Paul Willard	NEXTP007	5875

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/802,481	Applicant(s) WILLARD ET AL.	
	Examiner Narayanswamy Subramanian	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on June 22, 2006. The application number that appears on each page of the applicant's communication is incorrect. Amendments to claims 1 and 3-14 have been entered. Rejections made under the second paragraph of 35 USC § 112 are withdrawn in view of the amendments. Claims 1-14 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 10-14 recite in the preamble "transmitting a customized offer to an applicant". These claims also recite the limitation "receiving a plurality of terms requested by a customer". It is not clear if the "applicant" and the "customer" are the same person. If they are different persons, the relationship between the two is not clear. Further is not clear what the applicant means by the term "the selected offer meets at least one of the preferred requested terms, if possible". The metes and bounds of this limitation are not clear. What happens if it is not possible to find the selected offer meets at least one of the preferred requested terms. Appropriate correction/clarification is required. Further claims 1, 11 and 12 recite the limitation "using the requested term to select ...". It is not clear what the applicant means by "the requested

term”. Is it “another requested term” or “one of the plurality of terms requested by the customer” or “at least one of the terms is indicated by the customer as preferred over another requested term”. Appropriate correction/clarification is required. Claims 1, 11 and 12 also recite the limitation “the selected offer”. There is no antecedent basis for this limitation. In claims 1, 10-14 recite the limitations “the requested terms” and “the preferred requested terms”. It is not clear if these two are the same. Appropriate correction/clarification is required. In claim 3 it is not clear what the applicant means by the limitation “at least one of the requested terms is adjusted”. The metes and bounds of this limitation are not clear. Claims 5 and 9 recite the limitation “wherein selecting the offer”. There is no antecedent basis for this limitation. Claims 2-9 are rejected by way of dependency on rejected independent claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US Patent 6,014,645) in view of Walker et al (US Patent 6,374,230 B1).

Claims 1 and 12, Cunningham teaches a method and a computer program product for transmitting a customized offer to an applicant, the computer program product being embodied in a computer readable medium and comprising computer instructions for transmitting a customized offer to an applicant comprising determining a set of offers for the applicant (See

Cunningham Abstract, Column 4 lines 17-52); selecting an offer from among the set of offers to display to the applicant using information provided by the applicant (See Cunningham Abstract, Column 4 lines 17-52); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52). The limitation “to select from among the set of offers an offer to display to the applicant wherein if the set of offers does not include an offer that meets all of the requested terms, the selected offer meets at least one of the preferred requested terms, if possible” is an intended use of the step of using the requested term and as such is not given patentable weight. A computer program product being embodied in a computer readable medium and comprising computer instructions for performing the above steps are inherent in the disclosure of Cunningham.

Cunningham does not explicitly teach the steps of receiving a plurality of terms requested by a customer, wherein at least one of the terms is indicated by the customer as preferred over another requested term and using the requested term to select from among the set of offers an offer to display to the applicant.

Walker teaches the steps of receiving a plurality of terms requested by a customer (See Walker Col 2 lines 40-50, credit parameters are the terms requested by a customer), wherein at least one of the terms is indicated by the customer as preferred over another requested term (See Walker Col 3 lines 16-22, terms that customers desire are the preferred terms) and using the requested term to select from among the set of offers an offer to display to the applicant (See Walker Col 6 line 64 – Col 8 line 27).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the

time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 2, Cunningham teaches the step wherein a plurality of selected offers are selected and transmitted to the applicant (See Cunningham Column 6 lines 13-23).

Claim 3, Walker teaches the step wherein if it is not possible for any of the set of offers to meet at least one of the preferred requested terms, at least one of the requested terms is adjusted (See Walker Column 8 lines 42-50).

Claim 7, Walker teaches the step wherein obtaining a requested term from the applicant includes receiving the plurality of terms requested by the customer includes obtaining terms for a current card from the applicant and receiving desired changes to those terms (See Walker Column 6 lines 19-67).

Claim 8, Walker teaches the step wherein receiving the plurality of terms requested by the customer includes displaying a plurality of cards having different terms to the customer and determining which of the cards is requested (See Walker Column 1 lines 32-44).

Claims 4-6 and 9, Cunningham does not explicitly teach the steps wherein one of the terms is identified by the applicant as the most important term including preferred values for the most important term; wherein the requested terms are ranked by the applicant and selecting offers that have preferred values for the requested term.

Official notice is taken that ranking the user preferences for products/services that they wish to purchase and selecting offers according user preferences and ranking (of preferences provided by them) is old and well known in the art. For instance before buying a car a user may

indicate preferences for a car that has fuel economy, minimum size and one of a set of colors ranked in that order (Fuel economy ranked highest and color lowest) and he/she may further specify fuel economy such that the car must have a minimum rating of 30 mpg on highways. Matching cars that meet such specification and preferences and displaying these matches to the user is old and well known. This helps the users select the car that closely meet their needs and preferences.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include these steps. The combination of disclosure suggests that the applicants would have benefited by getting offers that closely meet their needs and preferences.

Claim 10, Cunningham teaches a method of transmitting a customized offer to an applicant comprising: determining a set of offers that meets at least one of the requested terms for the applicant (See Cunningham Abstract, Column 4 lines 17-52); selecting an offer from among the set of offers to display to the applicant using information provided by the applicant (See Cunningham Abstract, Column 4 lines 17-52); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52).

Cunningham does not explicitly teach the steps of receiving a plurality of terms requested by a customer, wherein at least one of the terms is indicated by the customer as preferred over another requested term.

Walker teaches the steps of receiving a plurality of terms requested by a customer (See Walker Col 2 lines 40-50, credit parameters are the terms requested by a customer), wherein at least one of the terms is indicated by the customer as preferred over another requested term (See Walker Col 3 lines 16-22, terms that customers desire are the preferred terms) and selecting from

among the set of offers using the requested term an offer to display to the applicant (See Walker Col 6 line 64 – Col 8 line 27).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 11, Cunningham teaches a system for transmitting a customized offer to an applicant comprising: an interface configured to: transmit a selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and a processor configured to: determine a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and select the selected offer from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37).

Cunningham does not explicitly teach the step of receiving a plurality of terms requested by a customer, wherein at least one of the terms is indicated by the customer as preferred over another requested term.

Walker teaches the steps of receiving a plurality of terms requested by a customer (See Walker Col 2 lines 40-50, credit parameters are the terms requested by a customer), wherein at least one of the terms is indicated by the customer as preferred over another requested term (See Walker Col 3 lines 16-22, terms that customers desire are the preferred terms) via a suitable terminal (See Walker Column 5 lines 39-51) and selecting from among the set of offers using a requested term an offer to display to the applicant (See Walker Col 6 line 64 – Col 8 line 27).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claims 13 and 14, Cunningham teaches a system and a computer program product for transmitting a customized offer to an applicant, the computer program product being embodied in a computer readable medium and comprising computer instructions for transmitting a customized offer to an applicant comprising: an interface configured to: transmit a selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and a processor configured to: determine a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and select from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37). A computer program product being embodied in a computer readable medium and comprising computer instructions for performing the above steps are inherent in the disclosure of Cunningham.

Cunningham does not explicitly teach the step of receiving a plurality of terms requested by a customer, wherein at least one of the terms is indicated by the customer as preferred over another requested term.

Walker teaches the steps of receiving a plurality of terms requested by a customer (See Walker Col 2 lines 40-50, credit parameters are the terms requested by a customer), wherein at least one of the terms is indicated by the customer as preferred over another requested term (See

Walker Col 3 lines 16-22, terms that customers desire are the preferred terms) via a suitable terminal (See Walker Column 5 lines 39-51) and selecting from among the set of offers using a requested term an offer to display to the applicant (See Walker Col 6 line 64 – Col 8 line 27).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Response to Arguments

6. In response to Applicant's arguments that "Neither Cunningham nor Walker, either singularly or in combination, teaches receiving a plurality of terms requested by a customer, wherein at least one of the terms is indicated by the customer as preferred over another requested term", the examiner respectfully disagrees. For instance Walker teaches the steps of receiving a plurality of terms requested by a customer (See Walker Col 2 lines 40-50, credit parameters are the terms requested by a customer), wherein at least one of the terms is indicated by the customer as preferred over another requested term (See Walker Col 3 lines 16-22, terms that customers desire are the preferred terms).

Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian *N.S.*
August 30, 2006

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